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10/588,189	08/02/2006	Philippe Boyer	0630-1009	6799
<div>466 7590 04/29/2011</div> <div>YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314</div>				
<div>EXAMINER</div> <div>FINDLEY, CHRISTOPHER G</div>				
<div>ART UNIT</div> <div>2482</div>		<div>PAPER NUMBER</div>		
<div>NOTIFICATION DATE</div> <div>04/29/2011</div>		<div>DELIVERY MODE</div> <div>ELECTRONIC</div>		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary

Application No.

10/588,189

Applicant(s)

BOYER ET AL.

Examiner

CHRISTOPHER FINDLEY

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 and 15 is/are rejected.
- 7) ☒ Claim(s) 9-14 and 16-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-040)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 2/14/2011 have been fully considered but they are not persuasive.
2. Re claims 8 and 15, the Applicant contends that the prior art cited fails to teach or suggest a control button on the elongated casing for controlling pausing/freezing of the video images. However, the Examiner respectfully disagrees. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). While Williams discloses command buttons implemented on the casing without mention of pausing/freezing, and Squilla discloses a pause/freeze button on a screen separate from the elongated casing, the Examiner respectfully asserts that one of ordinary skill in the art at the time of the invention would have found it obvious to combine the command buttons of Williams with the pause/freeze functionality of Squilla, thereby increasing portability and ease of use of the device (the object of the invention stated in Squilla column 2, lines 6-19) by encapsulating all of the control elements in the imaging device itself. Furthermore, the US court system has long established that such a shift in the location of parts does not constitute patentable subject matter when there is no unexpected benefit resulting from such a shift, *In re Japikse*, 86 USPQ 70 (CCPA 1950). In this particular instance the shifting of a pause/freeze command button from a video screen to the imaging device does not change the functionality of the command. The command button still performs a pause/freeze of the video images regardless of its location.
3. NOTE: the Applicant's amendment to the Specification is sufficient to overcome the prior rejection of claims 13 and 14 under 35 U.S.C. 112, first paragraph. The rejection under 35 U.S.C. 112, first paragraph, has been withdrawn.

Double Patenting

4. Applicant is advised that should claims 8-14 be found allowable, claims 15-21 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are

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duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (US 5771067 A, hereinafter referred to as "Williams") in view of Squilla et al. (US 7139016 B2, hereinafter referred to as "Squilla") in view of Miki et al. (US 6867380 B2, hereinafter referred to as "Miki").**

Re **claim 8**, Williams discloses a camera for medical or dental, use, comprising: an elongated casing (2) adapted to be held in a user's hand (Williams: Fig. 1) and provided at its anterior end with means for image-taking (Williams: Fig. 1 and 2 with column 5, lines 43-46, the optical system and the CCD camera are disposed in the distal portion of the elongated cavity of the housing), the casing (2) comprising means for control (6, 8) of a sensitive type (Williams: column 6, lines 44-48, external switches control a thermal printer, video processor, and recording device), the means for control comprising a zone of detection (9) located on the casing (2) which is defined by a surface discontinuity, a hollow or a crest (11) (Williams: Fig. 1: external switches 37 are shown surrounded by a ridge), wherein the casing (2) contains a sensor element (6) associated with an electronic piloting circuit (8) (Williams: column 6, lines 27-36, the external switches are electrically coupled to a video processor, a recording device, and a thermal printer).

Williams does not explicitly disclose that the control means is adapted to "freeze" on means for display (5) an image chosen by the user. However, Squilla discloses an intra-oral camera system, wherein a video control unit interacts through a CPU and user controls to provide functionality for several modes, including a mode for stopping the imagery at any point (i.e., "freeze-frame") (Squilla: column 5, lines 16-24). Since both Williams and Squilla relate to camera systems for use in dental applications, one of ordinary skill in the art at the time of the invention would have found it obvious to combine the freeze-frame capability of Squilla with the Camera housing of Williams in order to maximize the ease of use by the dentist by providing a compact, portable system capable of real-time control.

Neither Williams nor Squilla specifically discloses an electrostatic foam element (14) of which one end is applied against the sensor element (6) and its opposite end is applied against a zone of an inner face of the casing (2) disposed plumb with the zone of detection (9). However, Miki discloses an electronic apparatus, which includes push-switch clusters (Miki: Fig. 5 and column 4, lines 15-32), wherein the push-switch clusters have a center runner made of metal (Miki: column 4, lines 37-43), and the electrical potential of the center runner is fed to a touch-detecting means, which may be formed of an electrostatic sensor, so as to sense the electrostatic capacity of the center runner and output the sensed capacity to the operation controller (Miki: column 4, lines 43-47). Since the push-switches of Miki pertain to controls mounted on a camera apparatus, one of ordinary skill in the art at the time of the invention would have found it obvious to include push-switch buttons of Miki, incorporating electrostatic sensing material, on the housing of the combined system of Williams and Squilla in order to prevent unintentional operation of the camera functions, thus providing more accurate control of the camera device (Miki: column 4, lines 59-65).

Re **claim 15**, arguments analogous to those presented for claim 8 are applicable to claim 15, and therefore claim 15 has been analyzed and rejected with respect to claim 8 above.

Allowable Subject Matter

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7. Claims 9-14 and 16-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claims 9-14 and 16-21 recite particular characteristics of an electrostatic foam element that are not taught or suggested by the prior art. While the prior art renders the inclusion of an electrostatic material (such as foam) obvious, as noted above in the rejection for claims 8 and 15, the prior art of record fails to fairly teach or suggest the particular compression, shape, and resistivity characteristics recited in claims 9-12 and 16-21.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER FINDLEY whose telephone number is 571-270-1199. The examiner can normally be reached on Monday-Friday (8:30 AM-5:00 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Findley/

/Allen Wong/
Primary Examiner, Art Unit 2482